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**THIS DISPOSITION  
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Paper No. 17  
AD

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re David Judaken

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Serial No. 75/219,108

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Thomas I. Rozsa of Rozsa & Chen, LLP for David Judaken.

Catherine K. Krebs, Trademark Examining Attorney, Law  
Office 108 (David Shallant, Managing Attorney).

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Before Holtzman, Rogers and Drost, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 27, 1998, David Judaken (applicant) filed  
an intent-to-use application to register the mark GARDEN OF  
EDEN (typed drawing) for services identified as  
"restaurants and night clubs" in International Class 42.<sup>1</sup>

The Examining Attorney ultimately refused to register  
the mark under Section 2(d) of the Trademark Act because  
she concluded that registration of the mark for the

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<sup>1</sup> Serial No. 75/219,108.

identified services would be likely to cause confusion, or to cause mistake or to deceive under Section 2(d) of the Trademark Act because of the prior registration of the mark EDEN (typed drawing) for "restaurant services."<sup>2</sup>

After the Examining Attorney made the refusal final, this appeal followed. Both applicant and the Examining Attorney filed briefs. Applicant did not request an oral argument.

The Examining Attorney argues that the terms GARDEN OF EDEN and EDEN have the same meaning and connotation, so that when the marks are used on restaurant services, there would be a likelihood of confusion, mistake, or deception. The Examining Attorney has submitted numerous definitions and LEXIS/NEXIS articles to establish that the marks EDEN and GARDEN OF EDEN would have the same meaning or connotation. These definitions show that the word "Eden" is defined as "the garden where according to the account in Genesis Adam and Eve first lived" and "Garden of Eden" is simply defined as "Eden." *Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Edition* (1996). LEXIS/NEXIS printouts show that the terms "Garden of Eden" and "Eden" are often used together and interchangeably. "[T]he truly religious always realize you can't return to the Garden of Eden . . .

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<sup>2</sup> Registration No. 2,172,245, issued July 14, 1998.

even if Eden in this case was a burned-out, poverty-stricken borough." *New Times Los Angeles*, August 26, 1996. "Everyone has an ideal landscape, not necessarily a private Garden of Eden (though Eden should fit the bill, unless you love apples)." *San Antonio Express-News*, August 12, 1999, p. 5B. "Compare it to earth - this is the Garden of Eden. We may have our serpents, but this is Eden." *Lancaster New Era*, July 1, 1999, p. 12. "Heidi Ravven . . . plans to relate how . . . Jewish philosopher Maimonides dealt with the stor[y] of the Garden of Eden. Her symposium question: Does the Eden story suggest that man fell as a result of knowledge." *Jewish News of Greater Phoenix*, February 5, 1999, p. 4.

With her appeal brief, the Examining Attorney also submitted two additional dictionary definitions and concluded by arguing that: "Those consumers who are accustomed to dining at the registrant's EDEN restaurant would readily believe that the GARDEN OF EDEN restaurants originate from the same source, or are at least affiliated as to origin." Examining Attorney's Appeal Brief, p. 4.

Applicant responded to the Examining Attorney's refusal to register by arguing that "GARDEN OF EDEN is not the same as EDEN. They are not the same words, they are not pronounced the same, and they don't conjure up the same

image in the minds of the consuming public." Applicant's Appeal Brief, p. 3. Applicant submitted his own dictionary definition (*Webster's New Universal Unabridged Dictionary*), which contains a definition of EDEN but no definition of GARDEN OF EDEN. Further, applicant claims that because EDEN is in the dictionary he cites, but GARDEN OF EDEN is not, EDEN is a defined term while GARDEN OF EDEN "is its own fanciful unique phrase." Applicant's Appeal Brief, p. 4. "In addition, the most famous character[s] in the Bible relating to Adam and Eve are a snake and an apple, neither of which are part of the service mark of either the Applicant or the prior registrant." Id. Finally, applicant accuses the Examining Attorney of dissecting its mark to find a likelihood of confusion.

We have considered the arguments and the evidence presented by the applicant and the Examining Attorney, and because we determine that there would be a likelihood of confusion if the marks EDEN and GARDEN OF EDEN are both used on or in connection with restaurant services, we affirm the refusal to register the mark under Section 2(d) of the Trademark Act.

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re

E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start by noting that both applicant and registrant offer or will offer restaurant services. Therefore, in this regard the services are identical. In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) (Applicant's restaurant services identified as "restaurant services specializing in Southern-style cuisine" legally identical to registrant's restaurant services identified as "hotel, motel, and restaurant services").

Next, we turn to the similarity of the marks. "If the services are identical, 'the degree of similarity necessary to support a conclusion of likelihood of confusion declines.'" Dixie Restaurants, 41 USPQ2d at 1534, quoting, Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). The question here is whether the marks create the same

commercial impression. The test is not whether the marks can be distinguished in a side-by-side comparison, but whether they are sufficiently similar in their overall commercial impression so that confusion as to the source of the goods marketed under the respective marks is likely to result. "[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Here, both marks contain the identical word EDEN and they are in typed form. Applicant argues that by adding the phrase "GARDEN OF" to "EDEN," he creates a different commercial impression. We disagree. In a very similar case, the Board determined that there was a likelihood of confusion when the mark EDEN was registered for wine and the applicant applied to register the mark MT. EDEN VINEYARDS for the identical goods. In re McWilliams, 200 USPQ 47, 49 (TTAB 1978) ("While there may be a different connotation between the terms 'EDEN' and 'MT. EDEN' insofar as the word 'EDEN' might be interpreted as referring to the Biblical 'Garden of Eden,' whereas 'MT. EDEN' would refer to a particular mountain, we do not believe that such

difference in meaning between the respective terms would have any significant bearing upon the minds of prospective purchasers of wine insofar as the commercial impression created by such terms are concerned."). Unlike the McWilliams case where the mark MT. EDEN VINEYARDS might also have a non-biblical meaning, the evidence in this case supports the conclusion that EDEN and GARDEN OF EDEN would likely create the same commercial impression based on their similar biblical allusions.<sup>3</sup>

The following evidence supports our conclusion that the marks have similar commercial impressions. In the first definition the Examining Attorney cited, "Garden of Eden" simply refers back to "Eden." *Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Edition* (1996). In her brief, the Examining Attorney also requests that we take judicial notice of two additional definitions. The first defines "Eden" as follows:

1. The place where Adam and Eve lived before the fall. Gen. 2:8-24.
2. Any delightful region or abode; paradise.
3. A state of perfect happiness or bliss. Also called Garden of Eden.

*Random House Compact Unabridged Dictionary (Special 2d Edition)* (1996).

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<sup>3</sup> While applicant's dictionary does not contain a separate definition for "Garden of Eden," the definition of "Eden" is similar to the Examining Attorney's definition, i.e. "in the Bible, the first home of Adam and Eve."

The other defines "eden" as "the garden where Adam and Eve resided before the Fall (Gen. 2:8)." *Webster's Third New International Dictionary* (1986). We, of course, can take judicial notice of dictionary definitions, which we do in this case. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).<sup>4</sup> The LEXIS/NEXIS printouts also indicate that the term "Garden of Eden" is often shortened to "Eden." Therefore, we conclude that the marks create the same commercial impression. When the commercial impressions created by the terms are so similar and the services are also identical, confusion is likely.

The Board in McWilliams (200 USPQ at 49) went on to say:

[W]e believe that it is the word 'EDEN' in applicant's mark which creates the commercial impression and will have the greatest impact upon the minds of prospective purchasers as to the source of origin of the product identified by applicant's mark. Taking into account the fallibility of the human memory over a period of time and the other factors set forth above, we do not think that the differences between the respective marks including the differences in connotation between the terms "EDEN" and "MT. EDEN" are sufficient to

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<sup>4</sup> The Examining Attorney also attached a page from the New King James Version of the Bible, and she requests that we take judicial notice of the passage from the Book of Genesis (Chapter 2, Verse 8) referred to in her attached dictionary definitions. Since it is clear from the Examining Attorney's and applicant's definitions that Eden is a Biblical term, we do not need to take judicial notice of the actual quotation.



negate the likelihood of confusion arising from the contemporaneous use of such similar marks upon identical goods.

Applicant cites In re Merchandising Motivation, Inc., 184 USPQ 364 (TTAB 1974) to argue that there is no automatic rule that the addition of matter to a registered mark always result in a likelihood of confusion. While we agree that there is no absolute rule that one taking the entire registered mark and adding wording to it automatically creates confusion, there is a likelihood of confusion when the applicant's mark creates the same commercial impression. Wella Corp. v. California Concept Corp., 558 F.2d 1019, 1022, 194 USPQ 419, 422 (CCPA 1977)(CALIFORNIA CONCEPT and design held likely to be confused with CONCEPT for hair care products). In this case, when the marks are considered in their entirety, the addition of the words "Garden of" does not create a mark that has a different commercial impression from the registered mark.

Finally, applicant cites the du Pont factors and argues generally that there is no likelihood of confusion. He specifically refers to two factors: the similarity or dissimilarity of the marks and the fact that "there is no record showing that the cited registration for 'EDEN' is a strong and famous prior service mark." Applicant's Appeal

Brief, p. 12. We agree that there is no evidence concerning the fame or the strength or weakness of the registered mark. However, when the services are identical and the marks create the same commercial impression, it is not necessary that we find that the registered mark is a strong and famous mark for there to be a likelihood of confusion. We have previously discussed the similarity of the marks and we simply disagree with applicant when he argues that the marks are dissimilar.<sup>5</sup>

Decision: The refusal to register the mark under Section 2(d) is affirmed.

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<sup>5</sup> In addition to our previous discussion, we have taken into consideration the other du Pont factors in our likelihood of confusion analysis. Regarding the remaining factors, either there is no evidence, the factors are irrelevant because applicant has not alleged that it has used the mark, or the factors do not convince us that confusion is unlikely.